



PATENT  
0760-0298P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Ikuro MARUYAMA et al. Conf.: 8158  
Appl. No.: 09/980,624 ✓ Group: 1653  
Filed: March 28, 2002 Examiner: D. Lukton  
For: ADSORBENT OF HIGH-MOBILITY-GROUP PROTEIN  
AND BODY FLUID-PURIFICATION COLUMN

L E T T E R

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

March 18, 2005

Sir:

In response to the Notice of Non-Compliant Amendment (37 CFR 1.121) mailed February 18, 2005, the Examiner states:

"Withdrawn-Currently Amended" is not a proper status identifier.

Applicants respectfully submit that the Federal Register/Vol. 68, No. 125/Monday, June 30, 2003/Rules and Regulations, page 38617, clearly states:

"Combining the status identifiers (withdrawn) and (currently amended) into a single status identification, e.g., (withdrawn-currently amended), may be used in those situations where a claim has been previously withdrawn as non-elected but applicant wishes to amend the claim in an effort to rejoin the withdrawn (non-elected) claim with the elected invention. In all other situations only a single status identifier may be used."

In view of the above arguments, Applicants request the Amendment filed January 26, 2005 be entered of record.

Appl. No. 09/980,624

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Andrew D. Meikle, #32,868

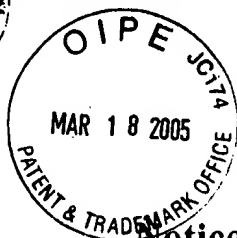
  
ADM/KJR/jmb

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachments: Copy of Notice of Non-Compliant Amendment (37 CFR 1.121)  
Copy of Federal Register/Vol. 68, No. 125/Monday June  
30, 2003/Rules and Regulations



## UNITED STATES PATENT AND TRADEMARK OFFICE

09/980,624  
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Paper No.

## Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 1-26-05 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see *68 Fed. Reg. 38611*, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following omission(s) or provision is required. **Only the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.**

## THE FOLLOWING CHECKED (X) ELEMENTS(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_
- ☐ 3. Amendments to the drawings: \_\_\_\_\_
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all claims (incl. withdrawn claims)
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: Withdrawn - Currently Amended is not a proper Status identifier.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given **ONE MONTH** from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is **not extendable**.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of **ONE MONTH** from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Legal Instruments Examiner (LIE)

(Not entered): Claim presented in a previous amendment document but which has either not been entered or the status of entry is unknown to applicant when a subsequent amendment to the claims is filed.

The status identifier "previously presented" must be used in those circumstances where: (1) A claim has been previously presented as "new" in a prior amendment document and entry of the claim is certain; and (2) a claim has been previously presented as "currently amended" in a prior amendment document. "Previously presented" should not be used for a claim which was previously presented in a prior amendment document, most particularly an after final amendment, and entry of the claim was denied or applicant is uncertain at the present time whether or not the claim has been approved for entry. The status of "not entered" should be used for such claims. It is foreseen that the latter described scenario could occur in those situations where a first after final amendment has been filed and applicant desires to file a second after final amendment prior to receiving a notice of allowance or an advisory action notifying the applicant whether or not claims presented or amended in the first after final amendment have been entered. Thus, the status of "not entered" should be used for claims which have not been approved for entry, or if it is not known if they have been approved for entry.

Patent Cooperation Treaty (PCT) amendment procedures (*i.e.*, PCT Articles 19 and 34(2)(b)) are applicable during the international stage of an international application, and thus status identifiers are not to be used during the international stage. During the national stage (pursuant to 35 U.S.C. 371), amendment rules under § 1.121 apply to preliminary and subsequent amendments. When submitting these amendments in national stage, a claim listing is required with status identifiers indicated in a parenthetical expression following the claim number. The status identifier may indicate that claims were "original," "previously presented," or "canceled" based on changes made during the international stage. More specifically, in an amendment under § 1.121 in national stage, the status identifier "original" must be used for claims that had been presented on or by the international filing date and not modified or canceled. The status identifier "previously presented" must be used in any amendment submitted during national stage for all claims added or modified under PCT Articles

19 or 34 in the international stage that were subsequently entered in the national stage. Similarly, the status identifier "canceled" must be used in any amendment submitted during national stage for any claims canceled under an Article 19 or 34 amendment in the international stage that was subsequently entered in the national stage. If the amendment under § 1.121 in the national stage is making a change in a claim, the status identifier "currently amended" must be used for that claim.

The Office will continue the current practice of entering all previously filed unentered after final amendments and amendments filed with a request for continued examination (RCE) under § 1.114, unless applicant instructs otherwise. Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. See MPEP § 706.07(h) (page 700-85). The claim listing in the most recent amendment will be used as the current claim listing. When applicant submits an amendment after final or an amendment with an RCE, the markings in the text of the claims should be made relative to the claims of the last entered amendment (or the original claims if no amendments have been entered). When filing an RCE, applicants are encouraged to present a comprehensive amendment that includes all of the desired changes previously presented in the unentered after final amendments along with specific instructions not to enter the after final amendments.

When claims are added, they must be numbered consecutively beginning with the number next following the highest numbered claim previously presented, whether entered or not. See § 1.126. Therefore, the claim listing in any after final amendment, or amendment filed with an RCE, should include the claim number(s) for any unentered new claims submitted in a previously filed after final amendment, the status identifier should be indicated as (not entered) and the text of such claims must not be presented. Consecutive unentered claims may be aggregated into one line (*e.g.*, claims 20-25 (not entered)) in the claim listing. If applicant wishes to represent the previously submitted but unentered new claims, the claim listing must include the new claims with claim numbers beginning with the number next following the highest numbered claim previously presented. The new claims must include the status identifier "new" and the text of the new claims.

The Office will also continue the current practice of entering unentered after final amendments that the examiner has indicated would be entered upon the filing of an appeal.

Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. The claim listing in the most recent amendment will be used as the current claim listing.

Combining the status identifiers (withdrawn) and (currently amended) into a single status identification, *e.g.*, (withdrawn—currently amended), may be used in those situations where a claim has been previously withdrawn as non-elected but applicant wishes to amend the claim in an effort to rejoin the withdrawn (non-elected) claim with the elected invention. In all other situations only a single status identifier may be used.

As a result of the changes to § 1.121, each amendment document will be self-contained, as it sets forth a complete listing of all claims, including the text of all pending claims, for examination and provides the status of all of the claims in one location in the file.

Paragraph (c)(1) provides for the presentation of the claims in ascending numerical order. This prevents the grouping of claims by status (all "new" claims together, all "currently amended" claims together, etc.), and ensures a complete listing of all claims in numerical order, regardless of status.

Consecutive "canceled" or "not entered" claims, however, may be aggregated (*e.g.*, "Claims 1-5 (canceled)"). Further, paragraph (c)(1) requires that any sheet of an amendment paper including part of the text of a claim shall not include material directed to any other part of the amendment or any remarks concerning the claims. In other words, the complete listing of all of the claims must commence on a separate sheet of the amendment document. This requirement facilitates indexing of the application papers.

Paragraph (c)(2) requires that markings be provided in claims to show the addition or deletion of subject matter. Added subject matter must be shown by underlining. If any claim is being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) For deletion of five characters or fewer, double brackets may be used (*e.g.*, [[error]]); and (2) if strike-through cannot be easily perceived (*e.g.*, deletion of the number "4" or certain punctuation marks), double brackets must be used (*e.g.*,